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PATENT
Attorney Docket No. 019404-001200US

TOWNSEND and TOWNSEND and CREW LLP

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Bennett Cookson Jr. et al.

Application No.: 10/748,441

Filed: December 29, 2003

For: GENEALOGICAL
INVESTIGATION AND
DOCUMENTATION SYSTEMS AND
METHODS

Confirmation No. 2382

Examiner: Nikolai A. Gishnock

Technology Center/Art Unit: 3715

APPELLANTS' REPLY BRIEF

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Commissioner:

This Reply Brief is submitted in response to the Examiner's Answer mailed on July 21, 2009. The following remarks are intended to further focus the issues in this appeal.

(3) Status of Claims

The Appellant and Examiner disagreed over the current status of the claims. Specifically, the Examiner maintained that claim 36 is also rejected as being anticipated by Huff (U.S. Pat. App. Pub. No. 2002/0032687 A1, hereinafter "Huff"). *Examiner's Answer*, p. 2, Heading 3. The final Office Action, dated November 12, 2008, does contain a rejection of claim 36, although it was incorrectly labeled at the beginning of the "Claim Rejection 35 USC § 102" Section. *See, Final Office Action*, pp. 3, 7. As such, Applicant agrees with the Examiner that

the correct status of the claims is that claims 1, 7-15, 18, 19, 21-34, 36, & 38-41 stand rejected under 35 USC §102(b) as being anticipated by Huff.

(4) Status of Amendments After Final

The Appellant and Examiner also disagreed over the status of amendments after the final rejection. The following clarifies the Appellant's previous "Status of Amendments After Final" and reconciles it with the Examiner's interpretation: No claims have been amended following the final Office Action dated November 12, 2008. A Request for Reconsideration was filed on January 8, 2009, and was entered by the Examiner.

(9) Grounds of Rejection

As a preliminary matter, the Examiner's Answer narrowly defined predetermined criteria as "merely numerical probabilities correlating the likelihood that two records represent the same person." *Examiner's Answer*, p. 12. Appellant notes that the Application does not define "predetermined criteria" as stated by the Examiner's Answer.

The Examiner has maintained the rejection of claims 1, 7-15, 18, 19, 21-34, 36, and 38-41. The Appellants' Brief and the Examiner's Answer focus on the following recitations of claim 1: "identifying pairs of records having similar data; [and] for each identified pair of individual node records, comparing related individual node records and deciding based on predetermined criteria whether the identified pair of individual mode records represent the same person." Claim 15 contains similar recitations.

The Examiner has taken an overbroad view of what may be rejected using 35 USC §102. The Federal Circuit recently reaffirmed that "unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to ... anticipate under 35 U.S.C. § 102." *Net MoneyIn v. Verisign* (Fed. Cir., Oct. 20, 2008). Appellants reiterate that Huff fails to teach or suggest all the limitations arranged or combined in the same way as recited in claim 1.

The Examiner's arguments are again lacking a showing of a *comparison* (for consolidation) of related individual node records. *See, generally, Examiner's Answer. No comparison of the records is made in Huff.* Rather, the portions of Huff cited by the Examiner's Answer focus on the process by which submitters may *delete* names from a genealogy database. *Huff*, ¶164. The Examiner's Answer walks through the process discussed in ¶164 of Huff, noting that Huff discloses: "The new name must have at least as many links backward (plus spouse and children - sideways and forward) as does the old name." *Id.* However, the determination of whether to *delete* the original record is made by a human examiner, following this initial check. *Id.*, at ¶166.

The Examiner is attempting to contort a manual process for deleting a name from a database into a *comparison* using predetermined criteria (for determining whether to consolidate information), as recited in claim 1. It is unclear how a deletion process requiring manual input may be read as *teaching* all of the limitations and *being arranged* in the same way as recited in claim 1.

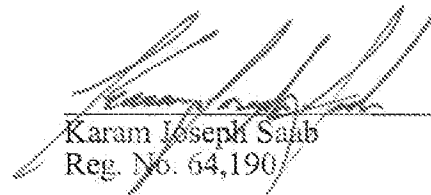
The Examiner's allegation that Huff uses "predetermined criteria" is equally unjustified. The Examiner's Answer states: "Huff is thus reasonably understood to use Appellant's disclosed step of having some predefined probability that, in view of other incidental data in the two records, the two records represent the same person." *See, Examiner's Answer*, p. 12. The Examiner does not provide a citation for this assertion. Further, Huff never discusses the possibility of a "predefined probability," as noted in the Appellant's Brief.

Bennett Cookson Jr. et al.
Appl. No. 10/748,441
Reply dated July 31, 2009
Reply to Examiner's Answer dated July 21, 2009

PATENT
Attorney Docket No. 019404-001200US

For at least these reasons, the Examiner has again failed to set forth a *prima facie* case of anticipation under §102. Accordingly, Appellant respectfully requests reversal of the Examiner's §102 rejection of claims 1 and 15 for at least the reasons further clarified herein.

Respectfully submitted,



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